

REMARKS

This document is filed in response to the final Official Action of July 9, 2007. The Official Action rejected all of the independent claims (1, 16, 31, 43, and 46) under 35 U.S.C. § 112, second paragraph, as being indefinite. The Official Action also rejected all of the claims pending in the application (namely, Claims 1-12 and 14-50) under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,795,711 to Sivula *et al.* (“*Sivula*”).¹ Finally, the Official Action rejected all of the claims based on non-statutory (obviousness type) double patenting in light of U.S. Patent Number 6,908,389 to Puskala (“the ‘389 patent”), which is the parent of the present application. All of the claim rejections are respectfully traversed herein. Reconsideration of the present application is respectfully requested in light of the following remarks.

I. Rejections Under 35 U.S.C. § 112

Independent Claim 1 of the present application is directed to, *inter alia*, a “system comprising: a service platform . . . comprising . . . providing means for providing along with . . . transmitted certain content at least one content-related predefined message to the user of the at least one wireless terminal based upon the certain content, the message being generated independently of the certain content and automatically modified based on an identity of the certain content . . .” Each of the other independent claims of the present application also makes reference to a “content-related predefined message to the user of the at least one wireless terminal based upon the certain content, the message being generated independently of the certain content and automatically modified based on an identity of the certain content.”

The Official Action indicated that “it is unclear to the Examiner how the message may be simultaneously based upon the certain content and independent of said content. This language renders the claim indefinite, as the Examiner cannot determine whether the predefined messages are either based upon the content or independent of the content.”²

The present application indicates that “[p]redefined messages are, for purposes of the present invention, defined as electronic messages whose contents are predefined and stored in a database or other file of messages for sending any number of times by one user to another user at

¹ The Official Action does not list Claim 31 in the statement of rejection on p. 5 of that document, but does discuss the rejection of that claim based on *Sivula* on p. 8.

² See p. 3 of the Official Action.

a later time.”³ The application continues that an “embodiment of the invention is directed to a system for enabling users of wireless terminals to communicate with one another using predefined messages which are related to a particular on-line service, such as, for example, an Internet web site, interactive program, streaming video and audio, etc., to which the users are or may be connected. The system includes an interactive program which supplies, upon request by a user, one or more predefined messages which are related to the content of the accessed on-line service.”⁴

An example of an embodiment that operates consistently with the above description, presented in an earlier Response filed by the Applicant,⁵ is where a user may be using her cellular telephone to listen to a music station and a predefined message related to the content (*i.e.*, the received music) is presented to the user. The predefined message could be, for example, “Hey, check out what’s on music station Z” or “Check out the new Britney Spears song on music station Z.” In this example, a predefined message is generated independently of the certain content (*e.g.*, “Hey, check out what’s on music station”) and automatically modified based on an identity of the certain content (*e.g.*, “Hey, check out what’s on music station Z”).

In light of the above cited passage and example, Applicant respectfully submits that the specification is clear regarding how a message may be both generated in a manner independent of certain content (by being, *e.g.*, predefined) and modified based upon the certain content (by adding, *e.g.*, a reference to certain content to the predefined message), and that the claims are sufficiently definite to satisfy the requirements of 35 U.S.C. § 112, second paragraph. Applicant therefore respectfully requests that all of the rejections based on 35 U.S.C. § 112, second paragraph, be withdrawn.

II. Rejections Under 35 U.S.C. § 102(e)

Independent Claim 1 of the present application recites providing a “content-related predefined message” to a user of a wireless terminal “based upon . . . certain content, the message being generated independently of the certain content and automatically modified based on an identity of the certain content . . .” where the “certain content” is identified in the claim as

³ See ¶ 0003.

⁴ See ¶ 0010.

⁵ See pp. 12-13 of Response dated March 4, 2005.

being provided by an “on-line service.” All of the other independent claims include similar recitations, although in some cases the “certain content” is recited as being provided by a “content provider.”

As discussed above, an example of an embodiment that operates consistently with Claim 1 is where a user may be using her cellular telephone to listen to a music station and a predefined message related to the content (*i.e.*, the received music) is presented to the user. The predefined message could be, for example, “Hey, check out what’s on music station Z” or “Check out the new Britney Spears song on music station Z.” The user can either send the provided content-related predefined message or not.

Sivula provides for the adaptation of special content messages between mobile telephones of different capabilities. A special application service center receives a special content message (*e.g.*, a message containing both text and images) from an originating mobile station and, in response thereto, sends a short message (using the existing short message service) to an addressed terminating mobile station with a notification of the nature of the intended special content message. The special application service center also sends an indication of an alternative method of receiving the special content message if the terminating mobile station is not capable of processing the special content message, for instance, a URL which the user can consult using his personal computer over the Internet. If the terminating mobile station is capable of receiving the special content message, it signals the special application service center which, after authentication, then forwards the special content message to the terminating mobile station for processing.⁶

The Official Action states that *Sivula* “discloses a system . . . such that if a wireless phone originating station chooses to send a special content message to a terminating wireless phone, a short descriptive message is provided to the user of the terminating wireless phone describing the incoming special content message. If the terminating phone has the capability to receive the special content message, the special content message is transmitted to and displayed on the terminating wireless phone. The content-related predefined message provides a description of the content as well as the requirements necessary to process the incoming content (col. 6, lines

⁶ See Abstract of *Sivula*.

34-61). Further, *Sivula* discloses that the content and related short messages may be predefined (col. 8, lines 28-44) as they may be stored on a central server and accessed by an originating wireless phone.”⁷

It is respectfully submitted that none of the cited portions of *Sivula* teach a message being “generated independently of . . . certain content and automatically modified based on . . . the certain content” as recited in each of the independent claims of the present application (in one form or another), and indeed this aspect is not taught anywhere in *Sivula*.

Sivula provides at col. 6, lines 34-61 (*i.e.*, one of the portions of *Sivula* cited by the Official Action) a special application service center that sends short messages to an intended recipient terminal indicating that a special content message is available and prompting indication by the intended recipient terminal of a capability to process the special content message. However, the above quoted portion of *Sivula* does not indicate that these short messages are predefined in any way.

Sivula further indicates at col. 8, lines 28-44 (*i.e.*, another one of the portions of *Sivula* relied upon by the Official Action) that “[i]t is also possible . . . that the originating mobile terminal has merely sent a request that a special content message be sent. In other words, although the originating mobile station may be capable of composing special content messages by itself or may have a set of default special content messages stored within, it is also possible that the special application service center will have a large number of special content messages stored within that can be made available on an uplink to the originating mobile station for further composition or that may be combined with a textual message from the originating mobile station . . .” As such, *Sivula* addresses the scenario where special content messages are predefined and provided for subsequent modification before transmission to another party. However, these modifications are not automatic, as they require input by a user, and are not based on any content provided by a content provider or by an on-line service, but are based on the user input. Further, the above-described functionality of the originating mobile station of *Sivula* has no relation to the short messages that are sent from the special application service

⁷ See pp. 5-6 of the Official Action.

center to the terminating mobile station, and does not indicate that these short messages are predefined in any way.

For at least the reasons presented above, Applicant respectfully submits that each of Claims 1, 16, 31, 43, and 46, as well as each of the claims depending therefrom, is patentable over *Sivula*. Because Applicant has argued that the independent claims of the present application are patentable over the cited reference, Applicant makes no representations regarding the arguments presented in the Official Action specifically concerning the patentability of the dependent claims.

III. Rejections Based on Double Patenting

The Official Action rejected all of the claims based on non-statutory (obviousness type) double patenting in light of U.S. Patent Number 6,908,389 to Puskala (“the ‘389 patent”), which is the parent of the present application. In response, Applicant is submitting herewith a terminal disclaimer dedicating to the public the terminal part of any patent granted on the present application that would extend beyond the expiration date of the full statutory term of the ‘389 patent. Therefore, Applicant respectfully requests that the rejections based on non-statutory type double patenting be withdrawn, consistent with MPEP § 804.02. Applicant also notes that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection.⁸

⁸ *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991).

CONCLUSION

In view of the remarks presented above, Applicant respectfully submits that all of the claims in the present application are in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

/Richard D. Emery/

Richard D. Emery
Registration No. 58,894

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111
LEGAL02/30520612v1

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON OCTOBER 9, 2007.